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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS OSTROWSKI, RAIMUND RUPPEL, EVA BAUM and
KATHRIN HARRE

Appeal No. 2010-000697
Application No. 10/578,874
Technology Center 1600

Oral Hearing Held: February 8, 2011

Before DONALD E. ADAMS, LORA M. GREEN and
STEPHEN WALSH, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Tuesday, February 8, 2011 commencing at 9:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.

PROCEEDINGS

2 - - - - -

3 THE USHER: Good morning. Calendar Number 24, Appeal No. 2010-
4 000697, Mr. Gron.

5 JUDGE ADAMS: Greetings.

6 MR. GRON: Your Honors, I have paper copies of the first claim in this case
7 and the patent, if you would like me to give you paper copies, so you can
8 look directly at them.

9 JUDGE ADAMS: We're good.

10 MR. GRON: May it please the Board, we have a rejection of all claims
11 under 102 over as anticipated by O'Connor. O'Connor does not describe all
12 the elements of the claim. That's the only rejection that we have.

13 The claim starts -- it's a very finicky reaction. The catalyst is such that
14 sometimes it starts on time, sometimes it doesn't. It's exothermic.

15 Sometimes it poisons the reaction after a certain period of time, sometimes it
16 doesn't.

17 But Applicants found the trick, I think, to getting the reaction to the steady
18 state. That's the key. The invention is to get the reaction to the steady state
19 as quickly as possible.

20 Therefore, they put in the initial charge, which may also be the starter, in
21 combination with this DMC catalyst. Then they meter into the pot from 100
22 to 3,000 seconds an alkylene oxide from zero to the amount that's required
23 for the steady state on a continuous reaction.

24 Now, simultaneous or thereafter, they meter in the starter substance. They
25 meter that in at a specific rate. It's got to get -- within 5 to 500 seconds, it

1 has to have the metering rate. Then after they get the pot filled with product,
2 they start pulling it off. They meter back in additional starter, additional
3 alkylene oxide, and additional catalysts.

4 Now, the reason they would need additional catalysts is when they're
5 drawing off the product, there's some catalytic residue in there. They've got
6 to put it back in.

7 What does O'Connor show? It took a while to ask the Examiner what it
8 shows because he wouldn't tell us. He would simply say look in the patent,
9 there it is.

10 Well, we looked in the patent, and I kept on looking and looking and looking
11 again in the patent; and I couldn't find all the steps. Specifically, I couldn't
12 find the addition of the alkylene oxide in a time from 100 to 3,000 seconds
13 and the addition of the starting material.

14 Now, there is a generic disclosure in O'Connor of a continuous process, and
15 you'll find that at Column 14, Lines 26-50. It basically says it's possible that
16 you can take our invention and apply it to a continuous process.

17 Now, there's nothing in there about metering in the alkylene oxide in any
18 specific time. There's nothing in there about metering in the starter material.
19 It just says it's possible, and possible is in line 49. It says process is
20 possible.

21 So continuous processes of this type are known, and in Applicant's
22 specification it says they are known. The real --

23 JUDGE ADAMS: Can I take you to Column 6 of the patent?

24 MR. GRON: Yes, Your Honor.

25 JUDGE ADAMS: Column 6, Line 33 -- in the 30s there between 30 and 35

1 -- it's talking about a reaction where you're adding DMC and you're adding a
2 particular alkylene oxide, and it says you can meter this in. The "time can
3 be minutes or hours depending on the catalyst" that you use.

4 MR. GRON: That's correct. It says depending on the catalyst, depending on
5 the reactants, et cetera, it can be in minutes or hours.

6 Which one? We don't know. It depends on the system, and --

7 JUDGE ADAMS: So 100 seconds -- a little over a minute -- to 3,000
8 seconds, that's a range within that range that they talk about there, right?

9 MR. GRON: And one would think that you could do it in any range within
10 minutes and seconds, except we have examples starting on page 10 of the
11 specification. The examples say, basically in Example 1.1, that if you do it
12 in five seconds -- each one of the additional added materials within five
13 seconds -- it takes something like 25 passes in order to get up to constant
14 rate.

15 JUDGE ADAMS: What happens when you get up to the minute? The
16 patent says you can do it in minutes to hours, right?

17 MR. GRON: Well, it depends on how many minutes.

18 JUDGE ADAMS: Well, no matter how many minutes it is, it's still not five
19 seconds, right? Didn't you say your example is five seconds?

20 MR. GRON: The first example is five seconds.

21 JUDGE ADAMS: Which examples show me minutes?

22 MR. GRON: The second example is on page 1.2, that is 7,200 seconds.

23 JUDGE ADAMS: What happens then?

24 MR. GRON: What happens is it takes 18 passes or 18 residence times in the
25 reaction in order to establish a constant or steady state production.

1 The steady state production is very important because if you start putting in
2 the various residual type materials in the first few minutes of the reaction,
3 your product is going to be -- well, it's not going to be optimum. You're
4 going to have residual materials in there that you don't want.

5 Now, that's 1.2. 1.3 is 600 seconds. Look at the difference. After five
6 residual times or residence times, we are able to get up to steady state.
7 Then it goes to Example 1.4. Again, we go to five seconds, five seconds,
8 five seconds. In five seconds each time, it takes 25 residence times on page
9 12, the last line.

10 Then we go to Example 1.5, 8,000 seconds, 23 residence times. These are
11 periods of time for checking the product to see how uniform the product is.
12 However, if we get to Example 1.6 --

13 JUDGE ADAMS: What's the residence time, again, for Claim 1?

14 MR. GRON: There is no residence time.

15 JUDGE ADAMS: So why do you keep telling me what the residence time
16 is?

17 MR. GRON: Because --

18 JUDGE ADAMS: In each example you emphasize the residence time in the
19 reactor, and the claim doesn't require that. So why are we talking about
20 that?

21 MR. GRON: Because we have the specific times which shows there's a
22 difference -- you just indicated, Your Honor, why isn't just any disclosure of
23 minutes or any disclosure of seconds sufficient. It's not. Because it doesn't
24 produce the same steady state in a sufficient amount of time. That's why it's
25 important.

1 The examples we have show that the time is very important.

2 JUDGE ADAMS: Okay.

3 MR. GRON: So we asked the Examiner, please tell us how we get the
4 metering times? How do we get up to this rate in these periods of time?

5 He said, first of all, look at the generic teaching of the continuous rate. Of
6 course, it doesn't have any metering times whatsoever. He said look at
7 Table 6 and look at the time it takes to get up to the initial temperature --
8 excuse me, the temperature for initiating the reaction.

9 He pointed to various starter types materials, and then the time to exothermic
10 peak, and then time to completion. Now, that's very important that you note
11 that time to completion because we have a continuous reaction.

12 Now, what's going on in these examples is actually -- O'Connor is only
13 interested in optimum starting materials. He found that if you have a large
14 distance between the two alcohol groups, or the three alcohol groups under
15 diol triols, therefore one part hangs onto the catalyst and the other part is
16 available for reacting.

17 So the larger the distance between the alcohol groups, the better the starter.

18 So he's looking for the best starters. He admits throughout that because I'm
19 looking for the starters, I'm not going to start off this reaction immediately.

20 The minute I get it started, game over. That's it. I don't have to look any
21 further.

22 So, consequently, he only puts a very specific amount of starter, catalyst,
23 and alkylene oxide in the pot initially. Then he tries to get it to start, and
24 then he measures how quickly it starts. That's what he's doing in that
25 example.

1 There's no metering in up to a constant rate and continuous metering of the
2 starter material, the alkylene oxide, the withdrawing.

3 Now, he does say in the column that it's possible. It takes a lot of
4 experimentation to give that a dry, and this is a very finicky catalyst, very
5 finicky reaction. It sounds like undue experimentation to me.

6 JUDGE WALSH: In the examples in Table 6, that's basically batch process

7 --

8 MR. GRON: Batch process.

9 JUDGE WALSH: -- according to your --

10 MR. GRON: As a matter of fact, in Column 6 it says that, Your Honor.

11 JUDGE WALSH: My question is: because of O'Connor's disclosure
12 elsewhere in the document that a continuous process can be done, don't these
13 numbers and time periods that are given in Table 6 -- don't they tell us the
14 addition for a continuous process would be in about that ball park of time?

15 Why isn't that telling you the same --

16 MR. GRON: A suggestion maybe, or obvious to try, Your Honor? Give it a
17 shot?

18 It's possible to do it. But this is an anticipation rejection. We need every
19 step in the reference, and it doesn't have it. Not a one.

20 As a matter of fact, at Column 6 it specifically says -- I'm pointing to
21 Column 6, starting at line 41 all the way down to around 53. It says: "The
22 data in Table 2-6 are based on the procedure of adding starter, PO" --
23 alkylene oxide -- "and catalyst initially."

24 There is no metering in until we get up to steady state of either the alkylene
25 oxide or the starter material. You add everything into the pot.

1 JUDGE ADAMS: So distilling your arguments all the way down,
2 essentially your argument is that the rejection before us is an anticipation
3 rejection.

4 O'Connor fails to meet the requirements because it fails to teach metering in
5 of its alkylene oxide, it fails to teach a continuous operation of the reactor,
6 and -- there was one other thing you said it fails to teach?

7 MR. GRON: It fails to teach withdrawing, adding the catalyst, continuing
8 all these other processes. It doesn't teach any of it.

9 JUDGE ADAMS: Okay.

10 JUDGE WALSH: Looking at Column 14, in that passage at Column 14,
11 around lines 26 to 34.

12 MR. GRON: Yes?

13 JUDGE WALSH: It says in a continuous process product is continuously
14 removed.

15 MR. GRON: That's right.

16 JUDGE WALSH: I agree it doesn't use the word metering, but here's my
17 question for you. If it says there that: "DMC catalyst, propylene oxide,
18 water or propylene glycole could be fed into the reactor continuously" ...
19 Now, I agree I don't see the word metering.

20 MR. GRON: Right.

21 JUDGE WALSH: But if he says it's fed continuously, how else would it
22 have been done other than by metering? Why isn't this a disclosure just
23 using different words?

24 MR. GRON: Excellent question, Your Honor. We have the six examples at
25 the end. When we add them in there too quickly, it doesn't work. It takes

1 like four times, five times the amount of time to reach steady state.
2 If we do it metered in at the times we set, we can establish steady state
3 within about five sequential periods. If we go past the amount of time that
4 we have set, now all of a sudden we're again back to 25 metering steps.
5 No one recognized that if you set the amount of time, the sequence of
6 addition, and the amount of time to reach up to continuous steady state batch
7 addition -- and if you do it within the periods of time that you have there --
8 you can establish the steady state of the reaction much faster than you could
9 if you went outside those boundaries.
10 The reference teaches either you add everything initially, which is the five
11 seconds, which says it's no good; or if you went later, it's no good again. We
12 have a very specific metering time.
13 JUDGE ADAMS: If I can distill it down again, your argument would be
14 even if it could be said that O'Connor teaches these specific steps, it does so
15 generically; and there's nothing leading you to the specific time periods that
16 we're talking about.
17 MR. GRON: Exactly, Your Honor, and that has a very, very beneficial
18 result.
19 JUDGE ADAMS: That's from your specification examples.
20 MR. GRON: Any further questions?
21 JUDGE GREEN: No.
22 JUDGE WALSH: No.
23 JUDGE ADAMS: Thank you.
24 (Whereupon, the proceedings at 9:18 a.m. were concluded.)
25